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By: Maureen Golob
Maureen Golob

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE APPLICATION OF: Hickman *et al.*

APPLICATION NO.: 09/648,715

FILED: August 25, 2000

FOR: **SYSTEM AND METHOD FOR ELECTRONIC
MESSAGE NOTIFICATION**

EXAMINER: S. Pannala

ART UNIT: 2177

CONF. NO: 6018

ATTORNEY DOCKET NO.:
59628-8001.US01

Transmittal of Reply

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Respectfully submitted,

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

EX PARTE Hickman et al.

Application for Patent

Filed August 25, 2000

Serial No. 09/648,715

FOR: SYSTEM AND METHOD
FOR ELECTRONIC MESSAGE NOTIFICATION

REPLY

CERTIFICATE OF MAILING

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Signature: Maureen Golob
Maureen Golob

I. GROUPING OF THE CLAIMS

The Examiner assumes correctly that Applicant considers each of the claims to stand or falls on its own, with the exception of the following three groups of claims to stand or fall together:

- A. Group 1, Claims 1 and 5, stand or fall with claim 1;
- B. Group 2, Claims 9 and 12, stand or fall with claim 9; and
- C. Group 3, Claim 14 and 17, stand or fall with claim 14.

Applicant apologizes for the clerical error in his Appeal Brief, indicating that there were only two groups of claims that stand or fall together (although the three groups were clearly listed).

II. CLAIM REJECTIONS

The Examiner has basically repeated his rejections as set forth in his Office Actions, in his Reply. Applicant again traverses the rejections as set forth previously in his Appeal Brief and prior Amendments and Remarks.

III. REPLY TO ANSWER ARGUMENTS

A. The Drawings

Applicant takes strong objection to the Examiner's characterization of the "quality of the drawings" as being "unethical." While Applicant disagrees with the Examiner's requirements with respect to the informal drawings presented in this case, that is no cause for the Examiner to impugn Applicant's ethics.

Applicant first set forth his objections to the Examiner's requirements for the drawings in an Amendment dated September 12, 2003. In that Amendment, Applicant responded to the Examiner's objections to the drawings as follows:

Applicant thanks the Examiner with her careful review of the drawings. Applicant proposes to address the comments made by the Examiner by amending the drawings as indicated in red on the enclosed photocopies of Figs. 1, 5 and 11.

With respect to the Examiner's suggestion of labeling element 11 as "network 2", this would be incorrect. Element 11 is a T1 line. Applicant labeled network 10 and network 10' as "NETWORK" in order to provide a response for the examiner. Likewise, Applicant labeled the computers 16 as "COMPUTER" and servers 18 as "SERVERS."

Applicant does not understand the Examiner's point with regards to elements 16 and 18. However, it is expected that the legends required by the Examiner satisfy her concerns. Furthermore, Applicant is unaware of the problem of having reference element 706 pointing to two types of actions. Would it be better if the two were encircled and having the element 706 point to the circle? Clarification is respectfully requested.

The Examiner also required that all parts of Figs. 1 and 5 be provided with a reference numeral or a legend. Since the only part of these figures that were not provided with a numeral or a legend was the universally understood digital storage symbol, Applicant addressed this requirement by labeling the storage symbol as "STORAGE."

The Examiner's comments concerning the decision operation "1108 in Fig. 11" is not understood, even with Applicant assuming that the Examiner meant Fig. 10B. The decision operation 1108 must include at least two outputs (in this case "no" or "yes"), or a decision is not made. Clarification is requested.

In view of the foregoing, Applicant believes that he has addressed the concerns of the Examiner, and respectfully requests the withdrawal of the objections to the drawings or further clarification.

The Examiner then responded with further objections to the drawings in an Office Action dated November 24, 2003. Since this Office Action was designated as "Final," Applicant responded to his renewed objections in his Appeal Brief as follows:

The Examiner objected to the drawings "because they fail to show necessary textual labels of features or symbols in Figs. 1-12 as described in the specification." Applicant respectfully traverses, and believes that his drawings fully meet the requirements of 35 U.S.C. 113 and 37 C.F.R. 1.83 and 1.84. In the view of most examiners, numbered elements are preferred over descriptive labels or including "a table next to the present figure..."

Applicant respectfully requests that the Examiner's objections to the drawings be withdrawn as being arbitrary, unnecessary and bureaucratic. Should the Board of Appeals and Interferences sustain the Examiner's objections, Applicant will modify the drawings as suggested by the Examiner.

Applicant therefore responded, noted where he agreed and disagreed with the Examiner, and asked for clarification. There is nothing unethical in those responses.

Should the Board of Appeals decide that this is a substantive matter, clarification is respectfully requested, as noted above. Should the Board of Appeals decide that this is a procedural matter, Applicant respectfully requests deferral of the resolution of this matter until after the Board's decision, so that Applicant can make a Petition to the Commissioner for the requested clarifications.

B. The Rejections under 35 U.S.C. 103(a)

1. Group 1 (Claims 1 and 5)

The Examiner asserts that Milewski discloses a docketing program at Fig. 7 and column 8, lines 30-37. This is clearly not the case. The paragraph from Milewski is reproduced below:

In FIG. 7, a message transaction is started in an operation 701 in which a sender uses the processor 30 at station 14 to access the controller 12 using conventional stored program instructions in the memory 34 for electronically linking the station 14 and the controller 12. As a part of accessing the controller, the sender identifies a structured object response template, previously prepared by the sender and stored in the controller. Milewski, col. 8, lines 29-37.

The Examiner has not met his burden in showing that a "structured object response template" is the same thing as a docketing program, as is "well known to those skilled in the art." This, in fact, is mere conjecture. The fact of the matter is that the Examiner has not made a *prima facie* showing Milewski teaches, show or suggest a docketing system.

The Examiner also asserts that Milewski teaches a docketing program "running a report." First, since there is no docketing system in Milewski, it cannot be said to run a report. The Examiner indicates that this limitation can be found in the Fig. 8, col. 9, lines 16-25 and Table 5). The paragraph from the specification is reproduced below:

In an operation 805, the recipient completes and returns the reply form to the controller. The controller in an operation 809 updates the action message

according to the responses or lack of responses received from the recipients. Optionally, the server updates the message content: either the message body 206 or the structured response objects. Table 4 lists pseudo code executable by the controller for updating the action message according to the responses or lack of responses by the recipients. Milewski, col. 9, lines 16-25

Applicant fails to see how this passage teaches that a report is generated from a docketing system. Furthermore, Applicant fails to see how this passage teaches the generation of a report at all.

The Examiner further asserts that Milewski teaches the limitation of "saving the report for further processing," and cites Fig. 1, col. 6, lines 2-19 as support. Applicant notes that this "report" is the report generated by a docketing system. Since the docketing report is not taught, described, or suggested by Milewski, saving a report is also not taught. This limitation, as well, is simply not found in Milewski.

Milewski furthermore does not teach the limitation of "obtaining a list of completed action items and emailing." Action items are docket reminders of tasks to be completed by a certain date. As is well known to those skilled in the art, multiple action items are often generated from a single event. For example, the filing of a patent application may create action items for checking for the return postcard, removing non-publication requests, filing IDS materials, etc. There is nothing in Milewski anywhere remotely related to the e-mailing of action items derived from a saved report of a docketing program.

The Examiner concedes that Milewski does not teach the limitation of "determining time for sending reminder notification," and attempts to use Ariyama to cure this deficiency. As noted, Milewski does not include limitations of this claim, and Ariyama does not cure this deficiency. That is, because the "missing limitation" added by Ariyama requires the limitations not found in Milewski, this "missing limitation" is not found in Ariyama. Therefore, the Examiner has not even made a *prima facie* case of obviousness in view of these references. The rejections of the claims of Group 1 should be reversed.

2. Claim 3

The Examiner points to Milewski in a general fashion, and indicates that the processing of the action items for a reminder notification action includes the limitations of: 1) reading the saved report into memory; 2) parsing the report into items; and 3) filtering out unwanted items. This rejection was addressed in Applicant's Brief, which is incorporated herein by reference. Milewski does not disclose these limitations. The Examiner should be reversed on the rejection of claim 3 as well.

3. Claim 4

Claim 4 was rejected "under the same rationale as dependent claim 3 because of the same limitations." This is clearly incorrect. Claim 4 provides additional limitations to the "for a report notification action" limitation of claim 1, while claim 3 provides additional limitation for the "for a reminder notification action" limitation of claim 1. Claim 3 and claim 4 therefore are entirely different limitations, and claim 4 cannot be rejected "under the same rationale" as claim 3. Furthermore, even if it were, *arguendo*, possible to reject under the same rationale as claim 3, that rationale is flawed, as set forth above. The rejection of claim 4 should be reversed as well.

4. Claim 7

Applicant respectfully traverses the Examiner's assertion that claim 7 "contains the same limitations as independent claim 1." Claim 7 is an apparatus claim (written in means-plus-function format), while claim 1 is a method claim. As such, claim 7 needs to be interpreted based upon the structure(s) disclosed in the specification and drawings, and their equivalents under 35 U.S.C. §112, ¶6. *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ 2d 1845 (Fed. Cir. 1994). The Examiner clearly had not done so. Furthermore, it is axiomatic that the prior art reference or combination of references must perform the *identical* function as set forth in the claim. Neither of the prior art references, singly or in combination, provide the function at all, let alone the *identical* function, as claimed in claim 7. The rejection of claim 7 should be reversed as well.

5. Group 2 (Claims 9 and 12)

The Examiner, while not objecting to the grouping of claims 9 and 12, still rejects these claims "under the same rationale as claim 1." This is clearly inappropriate. First, the statement that these two independent claims "have the same limitations" as claim 1 is simply incorrect. Furthermore, to the extent that there is overlap between limitations of claims 9 and 12 and claim 1, the Applicant's arguments as set forth in the Appeal Brief indicate why those limitations are not found in the cited art. Therefore, as set forth herein and previously, the rejection of the claims of Group 2 should be reversed as well.

6. Claim 11

Claim 11 was rejected by the examiner "under the rationale of claim 3." However, claim 3 is dependent upon independent claim 1, while claim 11 is dependent upon independent claim 9. While there might be overlap between claims 1 and 11, they are not the same claim. Furthermore, claim 11 was never grouped with claim 3 by Applicant, and the Examiner never traversed Applicant's assertion that claims 3 and 11 stand or fall on their own.

With respect to claim 11, there is no showing in the cited art that processing the action items includes: 1) reading the saved report into memory; 2) parsing the report into items; and 3) filtering out the unwanted items. The limitations are simply missing from the cited art, and the Examiner has not made a *prima facie* showing of obviousness. The rejection of claim 11 should be withdrawn.

7. Claim 13

Claim 13 was also rejected under the same rationale as claim 1. First, it should be noted that the combinations of limitations of claim 1 and 13 are different. Second, as noted above, the Examiner had not properly analyzed this claim as a mean-plus-function claim. For this claim to be rejected over the prior art, the reference or combination of references must show the *identical* function and the disclosed structure or its equivalents. *In re Donaldson Co., supra*. The Examiner has done neither and, therefore, has not made even a *prima facie* showing of obviousness with respect to this claim. The rejection of claim 13 should also be reversed.

8. Group 3 (Claims 14 and 17)

Once again, the Examiner has implicitly grouped claims 14 and 17 with claim 1. This is inappropriate as it is not the grouping suggested and argued by Applicant, and because the Examiner never traversed the grouping.

Claims 14 and 17 are different in scope than claim 1. They have different combinations of limitations. As such, Applicant can, and has, argued for their patentability independently from claim 1. These arguments are found in Applicant's Appeal Brief, and are incorporated here by reference. The rejection of the claims of Group 3 should be reversed.

9. Claim 16

The Examiner has once again regrouped the claims. Instead of standing or falling on its own, the Examiner has claim 16 standing or falling with claim 3. Again, this is believed to be in error, as set forth above with respect to other regroupings by the Examiner.

Claim 16 is dependent upon claim 14. As noted in Applicant's Appeal Brief and incorporated herein by reference, the examiner has not shown the "reading", "parsing" and/or "creating acts recited in claim 16 and, as such, has not made a *prima facie* showing of obviousness. The rejection of claim 16 should be reversed.

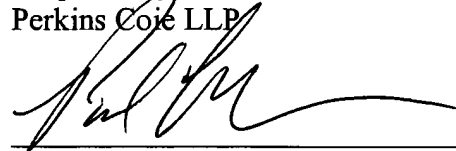
10. Claim 18

The Examiner has grouped the system claim of claim 18 with the method claim of claim 1, and had rejected it for the "same rationale" as set forth with respect to claim 1. As noted in Applicant's Brief, incorporated herein, this is another means-plus-function claim. The Examiner has not shown the identical function and the structure(s) disclosed in the specifications or there equivalents are found in the cited art. The rejection of this claim should be reversed as well.

IV. SUMMARY

Applicant incorporates herein all arguments made in his Appeal Brief. Applicant believes that the Examiner's objections to the drawings are incorrect, but will defer if required by a higher authority. Applicant also believes that the rejections to the claims are clearly in error, and should be reversed. Applicant respectfully requests a favorable holding on these issues from the Board.

Respectfully Submitted,
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